

REMARKS

In the Office Action mailed December 14, 2005, the Examiner rejected claims 1-4, 6-15, 17-30 and 32-36. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 6 and 34. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Rejections under 35 USC 103

The Office Action rejected claims 1-4, 6-15, 17-30 and 32-36 under 35 USC 103 as being unpatentable over combinations of the following references: Locke et al. (US 6,291,019); Burton (US 5,925,466); Wade et al. (US 5,580,945); Cannady, Jr. et al. (US 4,480,001); Meader, Jr. et al. (US 4,025,683); Uhran et al. (US 4,145,512); Thomaides et al. (US 5,626,840). Applicants traverse these rejections below.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an

obviousness holding") (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In the case of In re Rouffet (CA FC) 47 USPQ2d 1453, 1457-1458 (July 1998), the court wrote:

Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *See* 35 U.S.C. Section 103(a). This legal construct is akin to the "reasonable person" used as a reference in negligence determinations. The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *See In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ2d 1207, 1211 (Fed. Cir. 1993).

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements

would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Claim 1

The Office Action rejected claim 1 as being unpatentable over Locke et al. in view of Wade et al. The Office Action admits that Locke et al. is silent as to the use of aspartic acid ester, but then suggests that the use of the aspartic ester would be obvious in view of Wade et al. The Office Action reads:

...Wade teaches that by using aspartic acid ester in the amine component, the resulting coating is hard, elastic, abrasion resistant, weather resistant, and has increased flexibility. It would have been obvious ... to use aspartic acid ester in the composition taught by Locke. By doing so, one would reap the benefits of the coating being hard, elastic, abrasion resistant, weather resistant, and having increase flexibility.

However, Applicants contend that this suggestion by the Office Action lacks merit because there is no specific suggestion or motivation provided by Locke et al., Wade et al. or the knowledge of the skilled artisan that the use of the aspartic acid ester within a particular mixture of primary and secondary amines will create a coating with desirable properties as recited in claims 1 (i.e., wherein upon two weeks of water immersion at 32°C, or exposure to 100 % relative humidity at 38°C, the coating exhibits substantially no blistering, dulling or softening or loss of adhesion, and wherein the coating exhibits substantially no blistering, cracking or charring when sag panel tested for two weeks at about 70°C).

Wade et al. suggest that an aspartic acid ester must be matched with an organic acid to achieve the desired properties of their invention. Wade et al. particularly suggest that the organic acid is required to attain desired flexibility by presenting examples in tables 1 and 2 at col. 7, lines 20-55 wherein the improvement in flexibility is shown for formulations including the organic acid as compared to formulations without the organic acid. Applicants find no suggestion in Wade et al. to acquire desirable properties of claim 1 using a mixture of secondary and primary amines that includes aspartic acid ester along with the other limitations of claim 1.

Moreover, Locke et al. do not suggest any use of aspartic acid ester and, as such, Locke et al. do not suggest that desirable properties can be attained by a mixture of secondary and primary amines that includes aspartic acid ester. In view of the above, Applicants request that the rejection of claim 1 and its dependents, claims 4-7, 9, 10, 21, 22, 30 and 33-35 be withdrawn.

Claim 2

The Office Action rejected claim 2 as being unpatentable over Locke et al. in view of Burton and Cannady. Applicants traverse this rejection on the ground that the motivation provided by the Office Action is insufficient to sustain the asserted obviousness rejection and Cannady is an inappropriate reference to use in rejecting the invention of the present application.

The Office Action suggests that it would, "have been obvious ... to add potassium salts ... In doing so, static build-up is prevented." However, Cannady is directed toward the formation of laminates having print sheets "impregnated with a thermosetting resin, such as melamine-formaldehyde resin or other amino triazine aldehyde resin." (see col. 3, lines 27-35) Moreover, these laminates of Cannady are for use in "computer room flooring and desk areas". There is no indication in Cannady or elsewhere that the potassium salt used in Cannady would be suitable for use in an isocyanate/amine type coating such as that recited in claim 2, much less a suggestion that the potassium salt would be suitable for use in such coating as applied to a vehicle bedliner. Applicants respectfully request that the rejection of claim 2 and its dependents, claims 11-15, 24, 25, 32 and 36 be withdrawn.

Claim 3

The Office Action rejected claim 3 as being unpatentable over Locke et al. in view of Burton and Wade et al. Applicants contend that this rejection fails to establish a prima facie case of obviousness because it fails to consider language included in claim 3. In particular, claim 3 recites the robotic spraying of a vehicle bed liner. However, the Office Action never mentions this language in rejecting claim 3. As such, the Office Action has failed to establish a prima facie case of obviousness against claim 3. This failure is particularly poignant since the Office Action has also uses Burton to suggest the application of the coating of claim 3 to a vehicle bedliner, however, Burton is specifically directed to a process for applying a lining, "without the need for professional assistance or specialized equipment." (see abstract). Applicants respectfully request that the rejection of claim 2 and its dependents, claims 17-20 and 27-29 be withdrawn.

Claim 4

The Office Action rejected claim 4 as being unpatentable over Locke et al. in view Wade et al. Applicants contend that this rejection fails to establish a prima facie case of obviousness because it fails to consider language included in claim 4. In particular, the Office Action fails to consider the language of claim 4 reading, "wherein the step of contacting the surface with the composition includes spraying the composition upon the surface and wherein the surface is part of a bedliner of an automotive vehicle." Applicants respectfully request that the rejection of claim 4 be withdrawn.

Claim 13

Applicants traverse the rejection of claims 13-15 on the ground that they were treated as if they were dependent upon claim 3, however, they are actually dependent on claim 2. As such, the Office Action has failed to properly consider the claims of claims 13-15 in combination with the language of claim 2. Applicants respectfully request that the rejection of claims 13-15 be withdrawn.

Claim 19

The Office Action rejected claim 19 as being unpatentable over Locke et al., Burton, Wade et al., Thomaides et al. and Meader, Jr. et al. Applicants traverse the rejection of claim 19 on the ground that Burton teaches away from that which is claimed in claim 19 and, as such, the skilled artisan would not be motivated to combine Burton and Meader Jr. et al. in the manner suggested.

As suggested above, Burton specifically teaches a process for applying a polyurethane lining, "without the need for professional assistance or specialized equipment." (see abstract). Burton also suggests application by, "trowelling". (see col. 7, lines 1-5). Meader Jr. et al. is mainly directed to the application of polyurethane materials to "bridges". (see col. 1, lines 14-23). However, in contrast to both Burton and Meader Jr. et al., claim 19 reads that, "the composition is contacted with the substrate using an apparatus having a first metering container for receiving the second component, a second metering container for receiving the first component and a nozzle in fluid communication with the first and second containers for spraying the resulting composition." Moreover, claim 19 recites a polyurea coating that is robotically sprayed.

It is quite unlikely that the skilled artisan would, without the knowledge of the invention of the present application, modify a coating reference such as Locke et al. with one reference that teaches away from the use of "specialized equipment" (i.e., Burton) and with another reference that teaches a method of applying polyurethane coatings to "bridges" (i.e., Meader Jr. et al) to arrive at claim 19, which suggests the application of a polyurea coating (as opposed to polyurethane) to a vehicle bedliner using a metering system as described. Applicants contend that the rejection of claim 19 is based upon impermissible hindsight and respectfully request that the rejection be withdrawn.

Claim 33

Applicants additionally traverse the rejection of claim 33 since the Office Action has failed to address the language of that claim. As such, the Office Action has failed to establish a prima facie case of obviousness against claim 33. Applicants respectfully request that the rejection of claim 33 be withdrawn.

Moreover, Applicant points out that it would likely be improper to present a final rejection of the claims of the present application on a grounds alternative to that already presented since applicants have not amended the claims in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

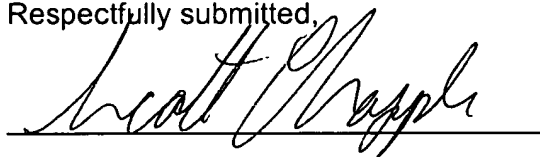
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

Dated: 13 March, 2006

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Scott Chapple", is written over a horizontal line.

Scott Chapple
Registration No. 46,287
DOBRUSIN & THENNISCH PC
29 W. Lawrence Street
Suite 210
Pontiac, MI 48342
(248) 292-2920

Customer No. 25215